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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,136	04/20/2005	Tetsuya Yano	03500.017651	6758
5514 7590 12/27/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER MESH, GENNADIY	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 12/27/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,136	<b>Applicant(s)</b> YANO ET AL.	
	<b>Examiner</b> Gennadiy Mesh	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 18-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 18-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 21, 2007 has been entered.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 18 – 36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1- 16 of U.S. Patent No. 6,645,743.

2.1. The claims of instant application and the claims of U.S. Patent No. 6,645,743 are not patentably distinct due to the overlap in the claimed subject matter :

Chemical structure of specific PHA claimed by Applicant in Claims 18 and 23 -26 encompasses chemical structure claimed by "743" due to open language of Claims 18 and 23 – 26.

2.2. Claims 18-36 are directed to an invention not patentably distinct from claims 1- 16 of commonly assigned U.S. Patent No. 6,645,743: see paragraph 2.1 above.

2.4. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 6,645,743, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon

the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Note, that due to amendment of Claims 1-2 and 4 ODP rejection over U.S. Patent No. 6,645,743 was overcome only for Claims 1,2 and 4.

3. Claims 1- 2 and 18 – 36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1- 2 and 20 – 21 of U.S. Patent No. 6,808,854.

3.1. The claims of instant application and the claims of U.S. Patent No. 6,808,854 are not patentably distinct due to the overlap in the claimed subject matter :

Chemical structure of specific PHA claimed by Applicant in Claims 1-2 and 18 -36 can be same as chemical structures claimed by "854" when Rz in Claim 1 selected from Formula (11).

Also, chemical structure of specific PHA claimed by Applicant in Claims 18 and 23 -26 encompasses chemical structure claimed by claims 1-2 and 20 - 21 of US Patent No. 6,808,854.

3.2. Claims 1-2 and 18-36 are directed to an invention not patentably distinct from claims 1-16 of commonly assigned U.S. Patent No. 6,808,854: see paragraph 3.2 above.

3.3. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 6,808,854 discussed above,

would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

4. Note, that ODP rejection over copending Application No.10/532,226 is overcome due to amendment of Claims 1- 4 of instant Application and amendment claims of Application No.10/532,226.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-2, 4 and 18 – 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Imamura et al.(EP 1 253 162) - note that US Patent 6,808,854 and published

Application US 2003/0100700 are an equivalents of EP 1 253 162. Published Application US 2003/0100700 will be used herein in order to simplify rejection.

Regarding chemical structure of PHA( polyhydroxyalkanoate) claimed in Claims 1 – 2 ,18 and 23 - 26 Imamura discloses PHA comprising unit of Formula(1) and /or unit of Formula (2) – see claim 1 and 2 and further comprising unit of Formula (3) – see claim 3.

Note that copolymer comprising same units same units claimed by Applicant in Claims 1 and 2 when Rz selected from Formula (11).

Regarding Claim 4 see Imamura [0062].

Regarding limitation of Claims 18-23 related to additional resin or additive see Imamura [0367], [0369],[0371],[0389] for resin and [0358],[0393], [0395] ,[0397] for additive.

Regarding limitations of Claims 24 and 25 related to decomposition of PHA by microorganisms see [0342].

Regarding Claim 27 Imamura discloses composition wherein binder constitute more that 50 wt.% of the composition – see [0358].

Regarding Claim 28 see Imamura [0376].

Regarding Claim 29 – see Imamura [0413].

Regarding Claim 30 see Imamura [0356].

Regarding Claims 33 – 36 see Imamura claims 27 – 30.

6. Claims 1-2, 4 and 18 – 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Imamura et al.( 6,808,854 ) – see rejection in paragraph 3 above.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

7. Claims 18 and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Honma et al.( US 6,645,743) - see rejection above, paragraph 2.1.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-2, 4 and 18 – 36 rejected under 35 U.S.C. 102(b) as being anticipated by Imamura et al.(EP 1 253 162) and ODP based on US Patent 6,808,854 have been considered but are moot in view of the new ground(s) of rejection.

9. As it was point out above – see paragraph 4 - ODP rejection over copending Application No.10/532,226 is overcome.



10. As it was discussed above – see paragraph 2 -2.4 Applicant overcome ODP rejection of Claims 1,2 and 4, but did not overcome rejection of Claims 18 -36.

***Conclusion***

**THIS ACTION IS NOT MADE FINAL**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gennadiy Mesh whose telephone number is (571) 272 2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272 1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gennadiy Mesh  
Examiner

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